

ARGUMENTS/REMARKS

Applicant would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicant regards as the invention.

Claims 1-43 have been canceled. New claims 44-66 have been added.

Various claims were rejected under 35 U.S.C. §103(a) as unpatentable over Cronin (U.S. Pat. App. 2001/0032145), or over Cornin in view of Bezos (U.S. 6,029,141). For the following reasons, the rejections are respectfully traversed.

The rejected claims have been canceled, making the rejections moot. The new claims filed in this case recite various features that are not found in either cited reference, making the claims patentable over the references individually, or on combination.

For example, new claim 44 recites the steps of "providing said affinity-website creation information and sending said creation information over the communications network in response to said requesting, said creation information including information describing an affinity organization". Neither reference teaches or suggests such steps.

Claim 44 further recites the step of "*automatically* generating, based on said creation information, an affinity website including a plurality of affinity website web pages based on said information, such that said affinity website operates as a website representing the affinity organization". None of the references suggest an automatic generation of a web site based on information describing an affinity organization.

Claim 44 also recites the steps of "providing an e-tailing website comprising a plurality of e-tailing web pages" and "automatically embedding a hyperlink to one or more of said e-tailing web pages in one or more of said affinity website web pages". Neither reference teaches or suggest such steps.

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Furthermore, claim 44 recites the step of "serving said e-tailing web pages to the one or more of the devices when users of the devices access said e-tailing web pages via said hyperlink, wherein said e-tailing web pages are then displayed on said devices utilizing said creation information, such that said e-tailing web pages appear to be an e-tailing website representing the affinity organization", which is also not taught by either of the cited references.

Accordingly, for any of the above reasons, claim 44 is patentable over the references. The remaining claims are patentable over the references because they either include limitations similar to those discussed above, or because they depend on claim 44 or another claim having similar limitations. Thus, new claims 44-66 are patentable over the references for at least the same reasons as claim 44.

Furthermore, claims 55 and 64 recite a business system as performing a number of steps. Neither reference teaches any such business system. Accordingly, claims 55 and 64 are patentable over the references for this reason as well. Claims 56-63, which depend on claim 55, and claims 65-66, which depend on claim 64, are thus patentable over the references for at least the same reasons.

In addition, the Examiner admits that Cronin does not teach a step of receiving information from an affinity group to create a custom website. The Examiner states that data identifying a group is "non-functional data". However, the amended claims clearly state that the information is used to create web pages that use such information, and thus the data is indeed part of the method as claimed. Accordingly, the data is not merely descriptive material, and thus the Examiner has failed to support a prima facie case of obviousness.

Finally, the Examiner has not provided the proper motivation for modifying the Cronin reference. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not

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sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner merely argues that the motivation would be to "efficient (sic) market and sell good (sic). This is a generalized benefit of the Bezos references and is not legally sufficient motivation for combining the references. There are many ways to efficiently market and sell goods. The Examiner must provide motivation for making the specific modifications suggested by Bezos to the Cronin reference, which the Examiner has failed to do.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

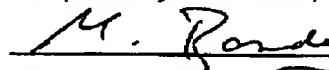
Accordingly, the rejections for obviousness is not supported by the Office action and thus the rejections are improper, and should be withdrawn.

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In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned to expedite prosecution of the present application.

Respectfully submitted,



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